- § 271(f)(1) is limited to supplying components from the United States in order to "actively induce the combination of such components outside of the United States in a manner that would infringe the patent if such combination occurred within the United States";
- § 271(f)(2) is limited to supplying components known to be "especially made or especially adapted for use in the invention," and it also requires an "inten[t] that such component will be combined outside of the United States in a manner that would infringe the patent if such combination occurred within the United States";
- § 271(g) provides remedies against importing products made by patented processes, but not when the product is "materially changed by subsequent processes" or "becomes a trivial and nonessential component of another product"; and
- § 105 provides that inventions "made, used or sold in outer space" are deemed "made, used or sold within the United States" if, but only if, the activity occurs "on a space object or component thereof under the jurisdiction or control of the United States"—and even then the statute contains exceptions for foreign-registered craft and matters addressed in international agreements.

The Federal Circuit's expansion of § 271(a) is a dangerous precedent that should be corrected by this Court. Otherwise, other nations may react to this expansion of American patent law by asserting their own (sometimes inconsistent) patent laws against transnational activities of American companies. The wiser approach is to leave it to Congress and the President to assess the competing policy concerns and to work out the proper political and diplomatic balance.

D. There Is No Need for the Courts to Expand § 271(a) to Cover Systems Spanning Multiple Countries

The Federal Circuit's holding may, as NTP suggests (at 21, 24) have been animated by a concern that a strict domestic construction of § 271(a) would result in international "dead zones" or "no man's lands" where inventors have no rights. That fear is misplaced for two reasons.

To begin with, patentees can readily avoid having transnational infringement "fall between the cracks" by drafting claims directed to systems of fewer components. Patent drafters are already taught to include claims covering individual components and various subcombinations of components as well as claims addressed to entire systems. *See, e.g.*, Robert C. Faber, *Landis on Mechanics of Claim Drafting* § 59 (4th ed. 1996). That approach minimizes the risk that no single person or entity may use the entire system. For example, in a system involving both transmitting and receiving components, applicants typically would include separate claims directed to each because the transmitting and receiving may be done by different people. The same technique of including claims with various combinations of limitations can address the possibility that some actions may take place domestically while others occur abroad.

In this case, for example, the patentees could have sought coverage in the United States for transmission and switching functions that occur in the United States. Instead, they chose to claim complete systems with many components and ran the risk that such systems would not be practiced entirely within this country. *Cf. Chef Am., Inc. v. Lamb-Weston, Inc.*, 358 F.3d 1371, 1374 (Fed. Cir. 2004) ("we construe the claim as written, not as the patentees wish they had written it"). Imposing such a drafting burden on patentees is not unfair. Indeed, under the Federal Circuit's decision, patentees already will face similar issues in drafting method claims. Moreover, as

the Federal Circuit itself has recognized, 35 U.S.C. § 112 "puts the burden of precise claim drafting squarely on the applicant." *In re Morris,* 127 F.3d 1048, 1056 (Fed. Cir. 1997).

In any event, should any "loophole" prove significant, Congress and the President are best situated to solve the problem. Contrary to NTP's suggestion, no one is arguing that the political branches are powerless to enact statutes or adopt treaties addressing transnational patent liability. Indeed, they did so in § 271(f) and (g). The fact of the matter, however, is that RIM's conduct does not fall within those provisions. Thus, the question here is whether the courts should distort the basic liability provision, § 271(a), to cover activities occurring in multiple countries. The Federal Circuit said yes. This Court should now take review and say *no.*

CONCLUSION

The petition for a writ of certiorari should be granted.

Respectfully submitted,

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January 4, 2006